

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Application No. 10/676,211

Applicant: Chesley P. Dillon

Filed: October 1, 2003

TC/AU: 2617

Examiner: CAI, WAYNE HUU

Docket No.: 252040 (Client Reference No. GP-303949)

Customer No.: 23460

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reasons stated on the following sheets.

REASONS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

There are clear logical errors in the outstanding rejections in this case. As a result, a prima facie showing of unpatentability has not been made. The primary error that necessitates reversal of the rejections will be discussed briefly below.

Status of Claims

Claims 1-20 and 22-24 are currently pending and stand rejected. Of these, claims 1, 8, 14 and 22 are independent. The pending claims can be found at pages 2-7 of the Amendment filed on July 6, 2006.

Summary of Claimed Subject Matter

The claimed subject matter pertains generally to a telematics subscriber event notification system. For example, an Onstar user may subscribe to one or more event notifications, and the notifications will be transmitted from the call center of the system to the subscriber's telematics unit for notification at the appropriate time. In the claimed system, the notification messages **not only** contain notification information, but also comprise a special indicator that causes an action (e.g., a change of the current radio station) to be automatically executed when the message is received.

Thus, to reiterate, the claimed system sends a notification message to the telematics unit. The notification message initiates two distinct occurrences: (1) it causes the user to be notified of the event, and (2) it causes an action to be automatically executed.

Grounds of Rejection to be Reviewed

Independent claims 1, 8, 14, and 22 stand rejected as obvious in view of Webb (U.S. 2002/0143664) (hereinafter "Webb"). Applicant will dedicate most of the discussion to these independent claims, since reversal of those rejections should moot the rejections of all dependent claims as well.

Reasons for Withdrawal of Rejections

Although Webb (“Network Based Gift Reminder and Purchasing System and Method”) does pertain generally to reminders sent over a network for events such as birthdays, the system of Webb does not operate in the manner that is expressly recited in the pending claims.

As noted above, the “notification” of the pending independent claims performs two functions, one of which is to notify the user of the event, the other of which is to automatically execute an action (e.g., changing the radio station, etc.) The notification of Webb does not serve both these functions, but rather serves only the first. That is, the notification of Webb does not cause an action to be automatically executed; it just notifies.

The Examiner has attempted to counter this logic by arguing that Webb’s notification indeed serves the recited dual function. However, the Examiner’s arguments are self-refuting. Consider the Final Action at page 3. The Examiner argues that the notification of Webb is dual purpose because the recited “action” encompasses Webb’s “automatically querying the Internet” to derive links which are later included in the notification. Even assuming this is accurate, it is still completely irrelevant for one simple reason: Webb’s notification **includes** the results of the queries – it doesn’t **cause** the queries. So even if Webb’s queries are deemed to be an action, they take place **before** the notification is even sent. They logically could not have been **caused by** the notification.

By analogy, consider the case of letter writing. In analogy to the pending claims, an arriving letter gives the user a notification and causes a later action. In the Webb system, an action occurs (the Internet queries), and is memorialized in the letter (as links) which is then sent. In the first case, the letter **causes** an action. In the second case, the letter merely **describes** an action that already occurred. These are not the same thing.

The Examiner, when questioned regarding the above problems with Webb, responded that the applicant’s “action” would encompass ANY action in Webb, regardless of whether the action occurs before or after the notification. See Advisory Action dated December 19, 2006. However, the Examiner’s response utterly ignores the actual claim language, which expressly

requires the recited “action” to be **caused by** the notification. *See* Claims 1, 8, 14 (“... subscriber notification including an indicator of an action ...to cause a notification to be conveyed to the user and to additionally cause the action to be automatically executed.”); Claim 22 (“... the notification including instructions to automatically perform the action.”)

The Examiner attempts to rationalize the rejections by simply denying that the recited notification must **cause** the action. *See* Advisory Action at page 3, second full paragraph. However, the claims are written in plain English and they are crystal clear on this point. The applicant is asking for nothing more than the opportunity to prosecute the claims as they were written, rather than with selected limitations ignored when convenient.

So, does Webb teach a “notification”? Sure.

Does Webb teach an “action”? Sure (querying).

Does the notification of Webb **cause** the action of Webb? No. And despite the Examiner’s protestations, that **is** an express limitation of every pending independent claim. Thus, Webb fails to teach at least one limitation of every claim, and cannot render any pending claim unpatentable.

Conclusion

It is respectfully noted that each and every pending rejection is improper since the cited reference fails to teach the recited limitations of each independent claim. Reversal of the pending rejections is requested.

Respectfully submitted,



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